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09/741,244	12/19/2000	Elizabeth Goldwyn Gibson	1906P	8208

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SAWYER LAW GROUP LLP  
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EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2614

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12/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/741,244

Applicant(s)

GIBSON ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This action is responsive to an amendment filed 10/08/2007. Claims 1-14 are pending.

### *Response to Arguments*

2. Applicant's arguments filed in 10/08/2007 Remarks have been fully considered but they are not persuasive.

### **Claim Rejections- 35 USC § 102:**

Regarding claims 1, 5, 8 and 11, the Applicant argues on pages 17-18 that **Foladare** does not teach or suggest the telephone, "wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox,". Examiner respectfully disagrees with this argument. In col.2, lines 23-30, col.8, lines 40-57, **Foladare** teaches a telephone for receiving the call from the calling party, by leaving the called party's telephone handset going off-hook to place a call to intermediate destination. It clearly means that the telephone joins the caller's talk path and the answering device's talk path. The teaching of **Foladare** reads on the claimed "provides a three-way call between the calling party, the called party, and the voice mailbox". It is because, the examiner interprets this limitation as providing call connection from the called

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party to the voice mailbox. That call connection is bridged to the calling party's call by forming a 3-way call and **Foladare** teaches such feature on col.2, lines 23-30, col.8, lines 40-57.

Thus the rejection of the claims in view of **Foladare** remain.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter i.e., the telephone provides a three-way call recited on claims 1 (lines 5-6), 5 (lines 3-4), 8 (line 5) and claim 11 (lines 4-5), which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original specification explains the invention on page 4, lines 11-18 as follows:

Figure 4 is a flow chart which describes a voice mail screening system in accordance with the present invention. Referring to Figures 3 and 4 together, first, the called party at phone 100 sets voice mail to pick up after a predetermined number off rings, in this case, two rings, via step 302, Next, the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call through line 102 of the voice mailbox 4", the called party at telephone 100 and the calling party at telephone 1" , via step 304. When the voice mailbox 4" picks up again, the telephone joins the three parties (calling party at telephone 1", voice mailbox 4", and called party at telephone 100), via step 306.

The paragraph states "Next, the telephone 100 performs a flash-hook(i.e., goes off hook), which initiates **three-way call** through line 102 of the voice mailbox 4", the called party at telephone 100 and the calling party at telephone 1" , via step 304". From this portion of the

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specification and applicant's arguments filed on 10/08/07, it is clear that the **three-way call** is only a regular outgoing call to the voice mailbox automatically dialed by the telephone 100. From "Newton telecom Dictionary" 19<sup>th</sup> Edition, the standard definition of Three-way call is "A local phone company feature that allows a phone user to add another user to an existing conversation and have a three party conference call". The definition states that it is the phone company with the switching system to PROVIDE a three-way call and bridge (JOIN) three parties together in the conference call. The examiner needs clarification from the applicant about support of the definition of "Three-way call" in the original specification. It is because, the original specification fails to support such definition.

Examiner has problem to match the claimed "the telephone **provides** a three-way call" to the disclosed "the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call" and "When the voice mailbox 4" picks up again, the telephone **joins** the three parties". It is not clear as to whether the telephone is **providing** any "three-way call" or the telephone is just outpost an ordinary call. The call will be bridged with the other two parties by the switch or the voice mailbox. Since the telephone didn't establish call path from either the calling party or the voice mailbox, there is no way for the called party's terminal to **join** the three parties.

The original specification fails to technologically describe as to how/when the telephone 100 automatically generate an outgoing call to the voice mailbox or the "three-way call". One of ordinary skill in the art would not be able to establish the claimed "three-way call" without undue experimentation.

Regarding the feature of bridging calls by a telephone terminal, such feature was very old (see Fuller et al. cited in Form 892). The claim would like to recite that the telephone terminal generates a second call to the voice mailbox after the first call routed to the voice mailbox. The telephone terminal joins/bridges the first call and the second call together inside the telephone terminal. However, the original specification does not teach such feature because the specification fails to disclose as to how the first call is related to the telephone terminal. The first call never connected the telephone terminal. How can the telephone terminal join the two calls together? If the voice mailbox/switch perform the bridge, how do they know these two particular calls need to be bridged?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-14, as best understood in light of the 35 U.S.C. 112, first paragraph rejections, are rejected under 35 U.S.C. 102(b) as being anticipated by **Foladare** et al. (U.S. Patent 5,960,064).

Regarding claims 1, 5, 8 and 11, **Foladare** teaches a telephone system has a switching system for receiving a call from a calling party (abstract; col.2, lines 13-16, col.8, lines 19-22) and

**Foladare** further teaches a voice messaging system [i.e., voice mailbox] coupled to the switching system for receiving the call if a called party does not place a return telephone call after expiration of a predetermined time period (abstract; fig.1; col.2, lines 21-23, col.8, lines 24-48). Since the called party does not return the telephone call within the predetermined time period, it is clear that the called party does not answer the call. Also, since the caller calls a personal telephone number of a called party's pager, the called party cannot answer the call. It is because, the pager can not go off-hook.

**Foladare** further teaches a telephone for receiving the call from the calling party, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox (col.2, lines 23-30, col.8, lines 40-57).

**Foladare** further teaches wherein the called party's telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox (col.2, lines 23-30, col.8, lines 59-62).

Regarding claims 2 and 12, **Foladare** teaches that the telephone further comprises first and second connections to the switching system, wherein one of the first and second connections is utilized to provide a the three-way call (col.2, lines 23-30, col.8, lines 40-57).

Regarding claims 3, 6, 9 and 13, **Foladare** teaches that the calling party inherently cannot hear the called party during the three-way call (col.2, lines 23-30, col.8, lines 40-57).

Regarding claims 4, 7, 10 and 14, **Foladare** teaches that the called party can, through interaction with the telephone, talk with the calling party through the other of the connections and the voice mailbox is dropped from the call (col.2, lines 23-30, col.8, lines 40-57).

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

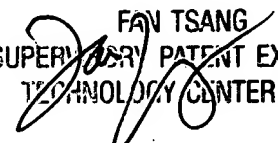


MD SHAFIUL ALAM ELAHEE

Examiner

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December 18, 2007



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